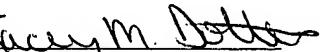




IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: STAHHMANN et al. Examiner: Toth, K.
Serial No.: 10/643,016 Group Art Unit: 3735
Filed: August 18, 2003 Docket No.: GUID.088PA
(02-087)
Allowed: December 14, 2007 Confirmation No.: 2956
Title: PREDICTION OF DISORDERED BREATHING

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this communication is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 14, 2008.

By: 
Tracey M. Dotter

MAIL STOP ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We are transmitting herewith the attached:

- Transmittal Sheet
- Please charge Deposit Account No. 50-3581 (GUID.088PA) the amount of \$1,740.00 (\$1440.00 for the Issue Fee and \$300.00 for the Publication Fee).
- Part B-Issue Fee Transmittal.
- Amendment after Allowance.
- Comments on Statement of Reasons for Allowance
- 1 Return Postcard.

Authorization is given to charge/credit Deposit Account No. 50-3581 (GUID.088PA) for any deficiencies/overpayments associated with this filing.

HOLLINGSWORTH & FUNK, LLC
Attorneys at Law
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700 (tel.) · 952.854.2722 (fax)

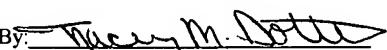
By: 
Name: Clara Davis
Reg. No.: 50,495

PATENT

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Applicant: STAHMANN *et al.* Examiner: Toth, K.
Serial No.: 10/643,016 Group Art Unit: 3735
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Title: PREDICTION OF DISORDERED BREATHING

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence and the papers, as described hereinabove, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 14, 2008.

By 
Tracey M. Dotter

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

MAIL STOP ISSUE FEE
c/o Technology Center 3600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Response to Arguments section of the Notice of Allowance, the Examiner appears to indicate that the statutory double patenting rejection under 35 U.S.C. § 101 made in the prior Office Action dated 06/29/2007 is moot only because of the amendments to the claims.

Applicant respectfully disagrees. A statutory double patenting rejection under 35 U.S.C. § 101 is only appropriate when the same invention is claimed twice. (See, MPEP § 804 (II) (A)) The original claims of U.S. Patent Application 10/643,154 (hereinafter ‘154) include at least one element not present in the claims of the present application. The presence of this additional element distinguishes the claims of the ‘154 application from those of the present application.

For example, claims 1-40 of ‘154 each include the limitation of delivering cardiac electrical stimulation therapy to mitigate predicted disordered breathing. Claims 80-100 of ‘154

include the limitation of a therapy delivery system. None of the claims of the present application include limitations directed to electrical stimulation therapy or to delivery systems configured to deliver therapy. Therefore, the claims of the present application cannot be drawn to the same invention as the claims of the ‘154 application.

The Examiner argues that the additional limitations of the ‘154 claims “do not preclude anticipation of the claims.” However, anticipation requires that each and every claim limitation be present. Here, the additional limitations present in the ‘154 claims preclude a double patenting rejection under 35 U.S.C. § 101.

A test for double patenting under 35 U.S.C. § 101 is whether there is “an embodiment of the invention that falls within the scope of one claim, but not the other. If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.” (See, MPEP § 804 (II) (A)) Clearly, there are embodiments that would fall within the scope of the original claims of the present invention (e.g., devices that do not deliver therapy) that would not fall within the scope of the claims of the ‘154 application. Thus, according to the test set forth in the MPEP, statutory double patenting is inapplicable here.

This paper is being submitted along with the issue fee payment. Applicant notes that the Examiner has not initialed references listed on a 1449 form mailed December 11, 2007. Applicant is paying the issue fee in this matter in reliance on the Examiner’s assurance during a telephone conference on February 8, 2008 that the initialed 1449 form would be forthcoming.

Unless Applicant hears otherwise, Applicant's comments herein are, as intended,
clarifying in a manner consistent with the law.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

By: 
Name: Clara Davis
Reg. No.: 50,495